

In response to Examiner's communication mailed May 13, 2002, the Applicants have made amendments to the claims to comply with 37 CFR 1.173(b) 2. Omitted matter is enclosed in brackets and new matter has been underlined as required by the rules. Cancelled claims are indicated by the statement "cancel" without presentation of the text as required by the rules. See MPEP §1453 (h).

As this response is solely to reply to the notice to comply with the reissue application amendments, the Examiner is respectfully directed to the Response to Office Action, mailed on January 23, 2002, for Applicant's traversal of the previous rejections.

SUPPORT FOR CLAIM AMENDMENTS

In claim 1, the amendment finds support at column 5, lines 13-32 and column 2, lines 15-17 of the reissue application as originally filed and has been made for clarity.

In claim 4, the amendment finds support at column 5, lines 55-67, column 6, column 7, lines 1-50 (examples 1-6) of the reissue application as originally filed and has been made for clarity.

In claim 5, the amendment finds support at column 3, lines 36-37 of the reissue application as originally filed and has been made for clarity and to recite back to claim 1 since claim 3 has been cancelled.

In claim 7, the amendment finds support at column 6, lines 15-67 and column 7, lines 15-38 of the reissue application as originally filed and has been made to recite specific compounds and a specific group of pests.

In claim 8, the amendment finds support at column 2, lines 15-17 of the reissue application as originally filed and has been made to recite specific compounds.

In claim 10, the amendment finds support at column 2, lines 15-17 of the reissue application as originally filed and has been made for clarity.

In claim 13, the amendment finds support at column 4, lines 41-45 of the reissue application as originally filed and has been made for clarity.

In claim 16, the amendment finds support at column 5, lines 15-32 of the reissue application as originally filed and has been made for clarity.

In claim 18, the amendment finds support at column 5, lines 15-32 of the reissue application as originally filed and has been made for clarity.

Oath

In addition, the Examiner states that the PTO failed to find an oath swearing the changes were not due to deceptive intent and identifying an error. Attached as exhibit "A" is Applicant's Reissue Declaration pursuant to 37 CFR § 1.172, which was mailed on January 7, 1998 in this reissue application.

CONCLUSION

In view of the above remarks and the amendments, the Examiner is respectfully requested to enter the amendments, withdraw the rejections and allow Claims 1, 4, 5, 7, 8, 10, 12-14, 16, and 18. Applicants believe the claims stand in condition for allowance. Applicants earnestly solicit such allowance.

If after review, the Examiner feels there are further unresolved issues, the Examiner is invited to call the undersigned at (415) 781-1989.

Respectfully submitted,

DORSEY & WHITNEY LLP

Dated: 6/10/02

By: David J. Brezner
David J. Brezner,
Reg. No. 24,774

Four Embarcadero Center - Suite 3400
San Francisco, California 94111-4187
Telephone: (415) 781-1989
Facsimile: (415) 398-3249
#1083951

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Reissue application of:

Ralph W. Emerson

Bradford G. Crandall

Patent No.: 5,536,501

Issued: July 16, 1996

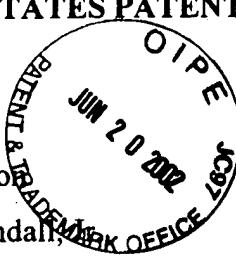
Reissue Serial No: Not Yet Assigned

Filed: November 24, 1997

For: USE OF AROMATIC ALDEHYDES

AS INSECTICIDES AND FOR

KILLING ARACHNIDS

Examiner: Not Yet Assigned
(Examiner S. Howard in parent case)

Art Unit: Not Yet Assigned

REISSUE DECLARATION
(37 C.F.R. 1.172)COPY OF PAPERS
ORIGINALLY FILED

RECEIVED

JUN 25 2002

TECH CENTER 1600/2900

BOX REISSUE PATENT APPLICATION

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

The undersigned is the assignee of 100% of the interest in the above-identified subject application by virtue of an assignment from the inventors, recorded in the Patent and Trademark Office (Reel 7358/Frame 0333). The assignee hereby states and declares that:

1. Assignee has reviewed the evidentiary documents and certifies that, to the best of assignee's knowledge and belief, title is in the assignee identified below.

CERTIFICATE OF EXPRESS MAILING"Express Mail" Label No.: EM 516292628 USDate of Deposit: 01-07-98

I hereby certify under 37 C.F.R. 1.10 that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" with sufficient postage on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C., 20231.

(Signature)

(Printed Name)

Exhibit A

2. Assignee does not seek to enlarge the scope of the claims of the original patent and may make the reissue declaration. 37 CFR 1.172

3. Assignee became aware on or about January 28, 1997 that U. S. Patent 5,536,501 is wholly or partly invalid by reason of claiming more than it had a right to claim in the patent; namely, claims 7, 12, 14-16 are overly broad. Assignee became aware of the invalidness of these claims when the references by Lewis *et al.*, Lampman *et al.*, and Metcalf *et al.*(copy enclosed) were reviewed on or about January 28, 1997 during the preparation of a response to the written opinion for a related case, PCT application WO 96/20596

Metcalf *et al.* (*J. Economic Entomology*, 82, 1620-1625 (1989) and Proc. Natl. Acad. Sci. 88, 1869-1872 (1991)) described a sticky trap containing cinnamic aldehyde adsorbed on cotton dental wicks that were attached to paper cottons covered with insect adhesive (1622 and 1870). Lewis *et al.* (*Environmental Entomology*, 19, 8-14 (1990) describe a sticky trap baited with a mixture containing trans-cinnamic aldehyde (P. 10). Lampman *et al.* (*J. Economic Entomology*, 80, 1137-1142, (1987) also describe a sticky trap baited with a mixture containing trans-cinnamic aldehyde (1142). The above references describe cinnamic aldehyde adsorbed onto cotton wicks and associated with a sticky trap which renders Claims 7, 12, 14-16 to be too broad. However, the references do not describe other formula (2) compounds associated with a solid support. The references describe cinnamic aldehyde associated with cotton wicks by physical adsorption; the references do not describe cinnamic aldehyde chemically coupled to a solid support (*see Specification, page 8, lines 7-23*). The error relied upon occurred because the Assignee was unaware of these references during prosecution.

Therefore, in the reissue application submitted herewith, Claims 7, 12 and 14-16 have been amended to avoid the references and a new Claim 17 has been added. Claim 7 is amended to exclude cinnamic aldehyde from the composition; and the subject matter of amended Claim 7 is not disclosed by the above references. New Claim 17 is added to recite a composition comprising a compound of formula (2), wherein said compound is coupled to a solid support. The subject matter of new Claim 17 was included in old Claim 7, but is not included in Claim 7 as amended. Therefore, it is necessary to add Claim 17 to cover the excluded subject matter.

4. Assignee became aware on or about November 1, 1996 that the '501 patent is wholly or partly inoperative or invalid by reason of the incorrect specification, namely the use of the generic term "flavonoid". Flavonoid aldehyde is not a correct term as it does not include

formulas (1)-(4). The definition of flavonoid is "a group of aromatic, oxygen-containing heterocyclic pigments widely distributed among higher plants". The flavonoids include the following subgroups: (1) catechin (2) leucoanthocyanidins and flavonones, (3) flavonals, flavones, and anthocyanins; and (4) flavonols. By definition flavonoids do not include compounds of formulas (1)-(4) which are not oxygen containing heterocyclic compounds, therefore flavonoid is not a correct generic term. Aromatic aldehyde is the correct generic term which should have been used; it includes compounds having formulas (1)-(4). The error occurred due to the inventors' infamiliarity with the correct chemical definition of flavonoid. The error was identified by an Examiner in an office action of a related application 08/486,943. Applicants became aware of the error while reviewing that office action to prepare a response. Therefore, Applicants are submitting amendments in this reissue application to change "flavonoid" to "aromatic" in each occurrence.

5. The defects in the '501 Patent occurred through inadvertent error without any deceptive intention on the part of the applicant; this reissue application is filed diligently.

6. Assignee believes that no new matter is introduced in any of the amendments. The amended Claims 7, 12, and 14-16 include an additional limitation. Claim 17 is supported at page 8, lines 19-22.

7. Assignee has reviewed and understands the contents of the reissue application including the amended claims and new Claim 17, and believes that the named inventors are the original and first inventors of the subject matter which is claimed and for which the reissue is sought.

8. Assignee acknowledges its duty under 37 C. F. R. §1.56 to disclose to the United States Patent and Trademark Office all information known to it to be material to the patentability of the claimed invention.

DECLARATION

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the application or any patent issued thereon.

Assignee: Proguard Inc.
Signature: 
Typed Name: Bradford G. Crandall, Sr.
Title: President & CEO
Address: P. O. Box 550, Suisun City, CA 94585
Dated: 12/1/97